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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,351	06/19/2000	Uwe Bunte	2598/207-150	4114

7590 04/09/2003

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EXAMINER

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

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DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/597,351

Applicant(s)

BUNTE, UWE

Examiner

M. Safavi

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☒ The proposed drawing correction filed on March 21, 2003 is a) ☐ approved or b) ☒ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

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Box 2: Contd. Proposed amendments to claims 3, 5, 12, and 13 would require further consideration and possibly further search.

Box 5: Contd. With regard to Applicant's arguments against Miura et al. The expansible shaped element 15 of Miura et al. is the same as the expansible shaped element 5 of Fig. 2. As for Hull et al. any space within Hull et al. to which Applicant alludes is the same as the "free space" presented within Figure 4 and described at lines 5-9 on page 8 of the instant application. Hull et al. does show the heat expansible element as being retained within a free gap between the half shells 20, 16. Thus, Hull et al. serves to read upon "said heat-expansible element being retained in said free gap between said half-shells". And, the Hull. et al. expansible shaped element serves to read upon "heat-expansible element" as recited in the instant claims with the final product of Hull et al. And, the final product of the instant invention, (i.e., foam insert), being one and the same. Otherwise, the patentability of a claim to a product does not depend on merely a difference in its method of production, but on whether the product itself is new and unobvious. *In re Pilkington*, 411 F.2d 1345, 1348, 192 U.S.P.Q. 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Fessman*, 489 F.2d 742, 180 U.S.P.Q. 324 (CCPA 1974) and *In re Thorpe*, 777 F.2d 695, 227 U.S.P.Q. 964 (Fed. Cir. 1985). When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the

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burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 450 F.2d 531, 173 U.S.P.Q. 685 (CCPA 1972). This burden is NOT discharged solely because the product was derived from a process not known in the prior art. *In re Fessman, supra*.

Box 8: Contd. It is not clear as to what Applicant is attempting to illustrate or describe with the proposed drawing changes of March 21, 2003. For example, with respect to the proposed amended Figure 4, to what does numeral 12 refer? To what does numeral 2 refer? Does numeral 2 truly reference "inner contour"? To what does numeral 5 refer? Does numeral 5 truly reference "border region"? To what does numeral 1 refer? Does numeral 1 truly reference "first half shell"? See Figure 1 versus Figure 4, for example. Does numeral 3 depict a "latching cylinder"? Why two of reference numeral 3 in Figure 4? What does each reference numeral 3 represent? It is not clear as to what, exactly, reference numerals 6 and 7 depict. In viewing Figures 1, 2, and proposed Figure 4 it is not apparent that reference numeral 6 depicts a free space slightly larger than the "inner contour". Or, that reference numeral 7 necessarily depicts a free space slightly larger than the "latching cylinder". If Figure 4 is showing a cross section through a latching element of connected first and second half shells how does free space 6 fall within the latching cylinder?

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**

M. Safavi
April 4, 2003